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No. 144

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JOHN C. KIRZER, JR.,

Petitioner

v.

JOHN A. MARSALL, Commissioner of Patents

[redacted]

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA

[redacted]

Reply to Brief in Opposition

[redacted]

Sol. Shapiro
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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1951

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MAY IT PLEASE THE COURT:

The type of rejection involved here is of the gravest import to patent law. In all cases before this Court that come to mind, where a patent is invalidated over a combination of citations, there has always been a concept of the invention in the prior art. A single citation discloses

the essential concept, and subsidiary patents or other citations are then relied on to show substitution of details.

But that is not what is being done here. No prior citation shows petitioner's design. One need only make a visual comparison with Harrison or Motorola or Philco to see that they do not give the mental impressions that are obtained from petitioner's design. So that here, a design patent is refused not because it is shown in the citations, but because after petitioner's disclosures and teachings, it is then possible to take isolated elements from the prior art and reconstruct them into an entity that is the result of petitioner's teaching. Such mental gymnastics are not permissible as a basis for refusal of patents.

The situation in the present case is like that referred to by Judge Luhring of the District Court in *Hurd* v. *Coe, Commissioner of Patents,* 17 F. Supp. 312, 315 (D.C.D.C.), in which it was stated:

> "The Patent Office has built up a hypothetical structure from a number of patents, and points to this as anticipating the plaintiff's claim. This practice is not approved by the courts. *Economy Appliance Co.* v. *Fitzgerald Mfg. Co.,* 35 F (2) 756; *Detroit Motor Appliance Co.* v. *Burke,* 4 F (2) 118; *Naylor* v. *Alsop Process Co.* 168 Fed. 911."

Also in *Hartford-Empire Co.* v. *Coe, Commissioner of Patents,* 87 F. 2d 741, 744, the Court of Appeals stated:

> "We have had occasion in many instances to condemn the hindsight nunc pro tunc method employed to justify the refusal of valuable inventions in which the patentees are entitled to the protection afforded by the Constitution and the laws."

The practice followed in the Patent Office and in the

court below is of the gravest consequence because it sets up an arbitrary standard for refusal of a patent based not on what has been done in the prior art, but rather on what facile minds may make out of the prior art in the light of petitioner's own contribution. Petitioner is pilloried on his own invention—and not on what was known before him. If such practice is approved the entire fabric of patent protection is destroyed.

It has become a commonplace occurrence to apply the stigma of "utilitarian" to a design patent and on that basis urge its non-patentability. The argument runs like this. The article has utility. Any part of it contributes to the utility of the article as a whole. Therefore, any feature of the design involves a part of the article and is "utilitarian." The position is vicious and destroys the very patent act itself insofar as design patents are concerned.

By statute, the design must be applied to an article of manufacture. The fact that the article may itself have utility has utterly nothing to do with patentability of the design as a new and ornamental contribution. Thus the fact that a handle is present to wind the instrument has utterly nothing to do with whether the design as a whole is a patentable entity. Consider the box itself. It also has utility, since it is a container. But that does not defeat patentability of a design for the box. Design patents have been granted on every conceivable type of article of manufacture —from perfume containers to locomotive headlights, etc., etc. The utility of the article qua article is no legal basis for attack against patentability of the design as a design.

The dangerous character of the Patent Office position is well illustrated by the argument at the top of page five of the brief in opposition. It urges rejection of the design without considering the features of the design at all, basing its attack on the fact that the design is applied to an article which has utility. It would be just as fallacious

to argue that a design for a fork is unpatentable because it must have a handle and it must have tines.

The argument on page five, first paragraph, defeats itself. It is that the design was evoked as a necessary response to engineering requirements. Why then does respondent not find the design in the prior art? Why then does respondent have to synthesize petitioner's design from isolated, unrelated elements in prior art citations, not from the teaching in the art, but in the light of petitioner's contribution? The elements of petitioner's design qua design could have been made in a million different ways and the specious argument based on obvious and necessary engineering practice is merely a shroud to cover the obvious deficiencies of the art. More so, it goes to the vitality of the design patent law itself and bids fair to sap what remaining strength it possesses. It is strange indeed to see the Patent Office itself, whose very existence depends on a virile patent practice, undermining the very basis for such practice.

Petitioner has utterly no quarrel with the decision of this Court in *A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U. S. 147, in the light of the facts of that case. But it has nothing whatsoever to do with the question of patentability of the design in the present case, unless indeed it is to show that the Patent Office is not infallible in its judgments, since it granted the patent which was held invalid in that case. But as certainly and correctly laid down in the *A. & P.* case, the fundamental question is whether the patentee has added to the sum of useful knowledge, or in the present design case, possibly we should say, has added anything to the sum of ornamental knowledge. And petitioner believes that the impression on the eye of the man in the street is so markedly different in the case of petitioner's design from that of any of the prior art as to require a holding of patentability.

The Patent Office position here has been destructive. It breaks the design down into individual elements, seeks out such elements in the prior art, and willy-nilly urges anticipation. That position avoids like the plague, the composite whole, the law of unification, the master's touch which runs through petitioner's contribution. Then brazenly respondent urges as law that all that is necessary (page eight) is to find separately appearing component parts in the prior art. There is no such acceptable law. In *Knapp* v. *Morss,* 150 U. S. 221, 227 this Court found that the elements of the Hall patent were all old in the art for the very same function and result. Exactly the same was true in *Howell* v. *Royal,* 93 F. 2d 112, where the elements of the chair of the design patent were old in combination. Again it may be noted that the Patent Office was in error in granting the patent in each of the cases cited. Its refusal in granting the patent here is just as erroneous and ill-considered.

Particularly is the rule as to permitted combinations of prior art references carefully applied where any of the elements must be modified before synthesis into the novel design. Yet this error is exhibited by the respondent. The latter takes each individual element from the prior art, modifies it, and then recombines in the light of petitioner's invention. Respondent cites the law against such practice.

In conclusion, it should be pointed out that there is a great deal more involved in the present case than whether Kurzen gets a patent. A pattern of refusal is being built by respondent that will plague the system of administration and jurisprudence for years to come and saddle the inventor with an incubus that defeats the very purpose of the Constitution and the Statutes in refusing the reward of a patent to him.

WHEREFORE petitioner prays as in his petition for writ of certiorari.

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September, 1951.